

Application No. 10/500,366  
Amendment dated  
Reply to Office Action of September 13, 2005

Docket No.: 22106-00060-US1

### REMARKS

Claims 2-21 are pending. Claim 1 is canceled. Claim 21 is new. Claims 2-20 are amended.

#### Specification Amendments

Line 15 of specification page 1 has been amended to correct an instance of non-idiomatic language. No new matter has been added.

#### Claim Amendments

New claim 21 has been added in place of canceled claim 1. Claim 21 is supported by original claim 1, lines 20-24 of specification page 4 and FIG. 1.

Claims 2-20 have generally been amended to improve readability and to provide proper dependency in view of the cancellation of claim 1. Claim 8 has been rewritten in independent form to recite the language previously incorporated by reference to claim 1.

No new matter has been added to the claims.

#### Objection to the Specification

Applicant respectfully requests withdrawal of the objection to the language "allow to obtain" at page 1, line 15 of the specification for being non-idiomatic language. The language in question has been amended to read "produces."

#### Claim Rejections - 35 U.S.C. §102

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 8 under 35 U.S.C. §102(b) as being anticipated by Mattes (U.S. Patent No. 6,143,998).

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In order for anticipation to exist, a reference must teach each and every element of a claimed invention. "The identical invention must be shown in as complete detail as is contained in the... claim". *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 has been canceled. Claims 21 and 8 now recite moving the laser means with respect to the joint while keeping a component of the angle of incidence of the laser means oriented along the same direction as relative motion between the laser means and the joint, so as to obtain an elongated weld. The claimed method allows two contact portions to be joined while minimizing reflections during the welding process.

Mattes discloses a welding method including providing spot welds to join a first contact to portions of an electrical contact of a circuit breaker (see, e.g., FIG. 15 of Mattes). Mattes further teaches embossing the two portions to be joined so as to offer the same surface to the laser beam, thereby reducing reflections during the welding process.

Mattes, however, does not mention forming an elongated weld between these elements. Furthermore, there is no disclosure of moving the laser means with respect to the joint while keeping a component of the angle of incidence of the laser means oriented along the same direction as relative motion between the laser means and the joint.

As described above, the claimed method achieves the same technical effect (reducing reflection during the welding process) of Mattes. However, as shown above, the claimed method achieves this effect in a very different manner. For at least these reasons, Mattes clearly fails to anticipate claims 21 and 8.

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Claim Rejections - 35 U.S.C. §103

*Rejection Based on Mattes*

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 2-5 and 13-17 under 35 U.S.C. §103(a) as being unpatentable over Mattes.

In order for a claimed invention to be obvious, all of the claim recitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 974). Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 2-5 and 13-17 now depend from claim 21. Mattes fails to teach or even suggest every element of claim 21 for the reasons stated above. Thus, Mattes does not render claims 2-5 and 13-17 obvious under 35 U.S.C. §103.

*Rejection Based on Mattes in view of Chang et al.*

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6, 7 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Mattes in view of Chang et al. (U.S. Patent No. 4,230,930).

Claims 6, 7 and 18-20 now depend from claim 21. As discussed above, Mattes does not teach or suggest the following features recited in claim 21: forming an elongated weld between the contact elements; and moving the laser means with respect to the joint while keeping a component of the angle of incidence of the laser means oriented along the same direction as relative motion between the laser means and the joint. Chang et al. also fail to teach or suggest these features. Therefore, the combined teachings of Mattes and Chang et al. do not render claims 6, 7 and 18-20 obvious.

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*Rejection Based on Mattes in view of Applicant's Admitted Prior Art*

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6-9 under 35 U.S.C. §103(a) as being unpatentable over Mattes in view of Applicant's Admitted Prior Art (AAPA).

Claims 6-9 depend from claim 8. As discussed above, claim 8 is allowable over Mattes because Mattes fails to teach or suggest the following features recited in claim 8: forming an elongated weld between the contact elements; and moving the laser means with respect to the joint while keeping a component of the angle of incidence of the laser means oriented along the same direction as relative motion between the laser means and the joint. The alleged AAPA cited by the Examiner also fails to teach or suggest these features. Therefore, claims 6-9 are allowable over the combination of Mattes and the alleged AAPA.

**Conclusion**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

If a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 22106-00060-US1 from which the undersigned is authorized to draw.

Dated:

*January 13, 2006*

Respectfully submitted,

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